

The Rejection under 35 U.S.C. 103(a) over Yoshihara et al.

Claims 1-12, 15-18, 21-32, 35-38, and 53-69 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshihara et al (US 4,940,578). Applicants respectfully traverse this rejection. The presumption of obviousness is overcome by Applicants' showing of unexpected results. Therefore, Applicants contend that the claimed invention is unobvious and that the rejection should be withdrawn.

Applicants have demonstrated unexpected results regarding the combination of a volatile liquid and a humectant for applying a skin active agent. Prior art scalp tonics, such as Yoshihara et al., have used volatile carriers to apply skin actives. Volatile carriers will dissipate quickly and provide a cool feeling to the scalp. However, they also tend to dry out the skin, especially after repeated use. They can also have a negative impact on hair cosmetics. Applicants have found that a humectant can be used in combination with a volatile liquid to provide an unexpectedly high degree of moisturization in a high drying environment.

The Declaration of Marjorie Peffly evidences these unexpected results. Various formulations were evaluated for their skin surface hydration values after 4 hours. The comparison of Example A to Example F shows the surprising benefit that a humectant (glycerine, in this case) can have on skin hydration. Each of these examples had a high level of ethanol (55%). The only difference between the formulations of Example A and Example F is the addition of 5% glycerine to the Example A formulation. The results show a dramatic improvement in skin hydration. Example F had a negative effect on skin hydration (-20.03) while Example A had a strong positive effect (207.75).

The Office Action states that the scope of the claims is broader than the scope of the Declaration, as the Declaration is limited to 5% glycerine. However, Applicants contend that the unexpected results are commensurate in scope with the claimed invention. Under MPEP 716.02(d), the nonobviousness of a broader claimed range can be supported by evidence based on unexpected results from testing a narrower range if one of ordinary skill in the art would be able to determine a trend in the exemplified data that would allow the artisan to reasonably extend the probative value thereof. The data in the Declaration exemplifies a common humectant, glycerine, within the range stated in the claim. Thus, the nonobviousness of the broader claimed humectants and humectant percentage range is supported by the evidence of a representative humectant and percentage of the humectant.

This evidence of unexpected results clearly rebuts the proposed *prima facie* case of obviousness asserted in the Office Action. Specifically, the Yoshihara reference does not explicitly disclose the combination of a volatile liquid, a humectant and a skin active agent, as

claimed by Applicants. Instead, Yoshihara et al. include some humectants in a long list of optional ingredients. Furthermore, Applicants' Declaration rebuts such a rejection by clearly establishing the unexpected results achieved by Applicant's invention.

Applicants respectfully contend that the *prima facie* case of obviousness has been properly rebutted. As such, Applicants respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn.

The Rejection under 35 U.S.C. 103(a) over Kashibuchi et al.

Claims 13, 19, 20, 33, 39 and 40 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Kashibuchi et al (US 5,565,207). Applicants respectfully traverse this rejection. Kashibuchi et al. does not establish a *prima facie* case of obviousness because it does not teach or suggest all of Applicants' claim limitations. Therefore, Applicants contend that the claimed invention is unobvious and that the rejection should be withdrawn.

The Kashibuchi et al. reference does not teach or suggest all of Applicants' claim limitations and therefore, does not establish a *prima facie* case of obviousness (see MPEP 2143.03). Kashibuchi et al. do not use a volatile liquid in combination with a humectant and skin active agent, as claimed by Applicants. Kashibuchi et al. is directed toward scalp moisturizers containing a combination of a glycoside, a glycolipid and a hormone. Kashibuchi does not use a volatile liquid in combination with a humectant and skin active agent, as claimed by Applicants. Since a *prima facie* case of obviousness has not been established, Applicants respectfully contend that this rejection should be withdrawn.

Even if a *prima facie* case has been established, Applicants have overcome the presumption of obviousness by a showing of unexpected results. Specifically, Applicants have demonstrated unexpected results regarding the combination of a volatile liquid and a humectant for applying a skin active agent.

The Declaration of Marjorie Peffly evidences these unexpected results. Various formulations were evaluated for their skin surface hydration values after 4 hours. The comparison of Example A to Example F shows the surprising benefit that a humectant (glycerine, in this case) can have on skin hydration. Each of these examples had a high level of ethanol (55%). The only difference between the formulations of Example A and Example F is the addition of 5% glycerine to the Example A formulation. The results show a dramatic improvement in skin hydration. Example F had a negative effect on skin hydration (-20.03) while Example A had a strong positive effect (207.75).

This evidence of unexpected results clearly rebuts the proposed *prima facie* case of obviousness asserted in the Office Action. Specifically, Kashibuchi does not explicitly disclose the combination of a volatile liquid, a humectant and a skin active agent, as claimed by Applicants. Instead, Kashibuchi include alcohols in a long list of optional ingredients. Furthermore, Applicants' Declaration rebuts such a rejection by clearly establishing the unexpected results achieved by Applicant's invention.

Applicants respectfully contend that the *prima facie* case of obviousness has been properly rebutted. As such, Applicants respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn.

The Rejection under 35 U.S.C. 103(a) over Yoshihara et al. in view of McKay

Claims 14 and 34 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshihara et al. in view of McKay. Applicants respectfully traverse this rejection for two reasons. First, the combination of Yoshihara et al. and McKay does not establish a *prima facie* case of obviousness because it does not teach or suggest all of Applicants' claim limitations. Second, even if a *prima facie* case was established, the obviousness argument is overcome by Applicants' showing of unexpected results. Therefore, Applicants contend that the claimed invention is unobvious and that the rejection should be withdrawn.

The combination of Yoshihara et al. and McKay does not teach or suggest all of Applicants' claim limitations and therefore, does not establish a *prima facie* case of obviousness (see MPEP 2143.03). Specifically, McKay does not teach or suggest a package having a plurality of openings through which a scalp cosmetic composition is applied directly to the scalp, as required by Applicants' claimed invention. Specifically, Applicants' claims 14 and 34 explicitly require that the package have "a plurality of openings through which the leave-on scalp cosmetic composition is applied directly to the scalp" (underline added for emphasis). McKay's fluid dispensing comb does not apply fluid directly to the scalp. McKay's device may apply fluid indirectly to the scalp as it runs off the hair. The Figures in McKay clearly show that the fluid-containing pad is placed higher in the comb than the point where the comb's teeth may contact the scalp. In fact, the comb is designed to only create direct contact between hair shafts and the absorbent pad. Therefore, McKay's device does not teach Applicants' claim limitation regarding direct application to the scalp.

Direct application to the scalp is important to prevent adverse hair cosmetics, as explained in Applicants' previous response. The Office Action states that this argument is unpersuasive because hair cosmetics are not part of the claim limitations. This is not necessary. The claim

limitation at issue is "applied directly to the scalp". The hair cosmetics discussion is provided to explain why that claim limitation is important. Since a *prima facie* case of obviousness has not been established, Applicants respectfully contend that this rejection should be withdrawn.

Even if a *prima facie* case has been established, Applicants have overcome the presumption of obviousness by a showing of unexpected results. As discussed above, Yoshihara et al. do not suggest the surprising improvement in skin hydration demonstrated in the Declaration submitted by Applicants. Therefore, Applicants contend that their claimed scalp cosmetic composition is novel and unobvious and that the rejection under 35 U.S.C. 103(a) should be withdrawn.

The Rejection under 35 U.S.C. 103(a) over Yoshihara et al. and McKay in view of Kellett et al.

Claims 41-46 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshihara et al. and McKay and further in view of Kellett et al. Applicants respectfully traverse this rejection for the reasons laid out above regarding the combination of Yoshihara et al. and McKay. Specifically, the combination of references does not establish a *prima facie* case of obviousness because it does not teach or suggest all of Applicants' claim limitations. Also, even if a *prima facie* case was established, the obviousness argument is overcome by Applicants' showing of unexpected results. Therefore, Applicants contend that their claimed invention is novel and unobvious and that the rejection under 35 U.S.C. 103(a) should be withdrawn.

Conclusion

Applicants have made an earnest effort to distinguish their claimed invention from the applied prior art. WHEREFORE, reconsideration of this application, withdrawal of the rejections under 35 U.S.C. 103 and allowance of Claims 1-46 and 53-69 are respectfully requested.

Respectfully submitted,
Marjorie Mossman Peffly, et al.

By BMP
Brent M. Peebles
Attorney for Applicants
Registration No. 38,576
(513) 626-2404

December 3, 2002
Customer No. 27752